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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/828,417			

EXAMINER

ART UNIT	PAPER NUMBER
	3

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/828,417	Mirasaki et al.
Examiner	**Group Art Unit**
J Hotaling II	3713

☒ Responsive to communication(s) filed on *Mar 28, 1997* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-22* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-22* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 7 line 4 reference is made to a speaker 5b but no reference is made to speaker 5a. On the last line of page 7 both speakers are referenced in outputting the speech data. Page 10, line 9 the "airfgf.box" seems to be the incorrect box and may be airgrf.box. For examination purposes the above will be considered typographical errors.

Appropriate correction is required.

2. Page 16 last paragraph. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Objections

3. Claim 1 is objected to because of the following informalities: On the fifth line of the claim "... which matches monitored condition..." The monitored condition is never positively claimed. If the applicant would like to positively claim the monitored condition it is recommended that "a" be placed between matches and monitored. Appropriate correction is required.

Claim 18 is objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 18 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for changing the words depending on the situation as found on page 9 lines 11-21, does not reasonably provide enablement for the processing section to determine a specific phrase for a wild card based on the state of progress in the game. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification clearly states that the "...wild cards are parameters that cannot be stipulated in advance in the program.." and are like fill in the blank spaces in the phrases as the game progresses (e.g. time elapsed and time of possession) and for each game where different team parameters change (e.g. team name and players names). Claim 5 states that the processing section determines a specific phrase for a wild card on the basis of the state of progress in the game. Claim 1 and the specification do not select a phrase based on the a wild card but rather based on the game progress.

5. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The preamble of the claim makes reference to a medium whereon programs for causing a computer to function as a processing section and speech output device but does not positively claim anything. The portion of claim 18 "...any of claims 1-17 are stored." is indefinite since it is impossible to store hardware on a medium. In addition, claiming a computer disk containing a program is not statutory.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 recites the limitation "phrases data" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim. It is recommended that "said phrase data" replace what is in the claim to overcome the insufficient antecedent basis. In addition, Claim 8 recites the limitation "said phrase databases" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. It is recommended that "said plurality of phrase databases" replace what is in the claim to overcome the insufficient antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1 and 19 are rejected under 35 U.S.C. 102(b) as by anticipated Murata et al. Japanese publication number 2,552,425 abbreviated as Murata '425 in this office action. In addition all page and line numbers will be from the translation as provided by the USPTO.

As to claims 1 and 19 Murata '425 discloses on page 4 line 14 through page 5 line 12 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a glossary of terms corresponding to the proceedings of the game, and a

database of the on the spot broadcasting terms with a voice output means which converts the stored data into and audible speed voice. Page 7 last paragraph discloses that the CPU specifies the appropriate terms corresponding to the proceedings of the games and the operational details of the output of the play by play commentary. The glossary of terms or the on-the-spot-broadcasting terms are data regions which are stored vocal sound data on databases and are well known in the art

Claims 1 and 19 are rejected under 35 U.S.C. 102(e) as by anticipated Murata et al. '743 abbreviated Murata'743

As to claims 1 and 19 Murata '743 discloses in column 1 line 49 through column 2 line 5 a processing section or manipulator for monitoring the state of the game, a play-by-play announcement for a plurality of phrases or vocal sound groups, a controller to produce a new game scene and designate data for vocal sound suitable to the produced new scene. The plurality of phrase databases and plurality of phrases relative to a predetermined condition that the processing section selects from is disclosed on column 4 line 50 through column 6 line 25 where the plurality of databases are the vocal sound data storage portion. These data regions which store vocal sound data are databases. Column 4 lines 25-32 and column 7 lines 1-11 disclose the sound manipulation and output of the vocal sounds.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata '425 as applied to claim 1 above, and further in view of Lowe et al '401. Murata '425 discloses all of the claimed invention as outlined above but lacks a feature that suspends commentary. Instead Murata '425 discloses on page 12 lines 6-16 an adjustable interrupt timer that transfers the terms one at a time. In an analogous machine Lowe et al. '401 ,column 11 lines 15-21, teaches that it is known to mute the play by play commentary and replace it with an audio insert which may be silence or a alternate sound such as music or a commercial. One skilled in the art would understand the teachings of Lowe et al. '401 because of the use of speech, commentary,

or an alternate sound associated with a game machine. It would be obvious to combine Murata '425 with Lowe et al. '401 in order to provide a break in the commentary so that it can be replaced with an alternate sound associated with the game machine or just to mute the commentary.

Claim 1, 2, 5-17, and 19-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Murata as applied to claims 1 and 19 above, and further in view of Best '073, Best '152 and Ostrover et al. Murata discloses all of the claimed invention as covered in the above rejection but lacks in disclosing alternative phrase databases, switching from database to database based on switching commands a predetermined procedure or player action, and same size databases, wild cards, and alternate languages. In an analogous process Best '073 discloses the use of alternate phrase databases on figure 11 and column 11 lines 45-50 that may be stored on a disk or in memory, can be used based on the selection of a player which is player action or based on a switching command from the machine which is also a predetermined procedure. Best '152 in column 10 lines 39-70 and column 11 lines 1 and 2 disclose that the audio cue commands are of a fixed length record which are stored into a cue table and that these audio clips where a predetermined procedure for a branch point may abandon some audio cues and select others. Ostrover et al. discloses on column 12:30-50 that his invention which is the use of alternate language databases stored on a computer readable medium that can be used with a video game. The art benefits from the Best patents in that automatic or player selected switching from database to database will result in a games that will have multiple story plots and will not be

predictable and from the Ostrover patent in that he discloses that many languages can be associated with a movie or alternatively with a video game. One skilled in the art would understand the teachings of Best and Ostrover because database manipulation , storage and retrieval is well known in the art. It would be obvious to combine the above references in order to have a commentary on a video game that is variable and can be of a different language in order to market a product in multiple countries.

Citation of Pertinent Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lowe et al '275 discloses a play by play commentary in a video game

Edelstein '104 discloses synchronization of a visual response with an audio input

Carter '107 discloses providing independent audio to multiple players in a video game

Cookson et al. '950 discloses an alternate language associated with a video game

Ostrover et al. '370 discloses an alternate language associated with a video game

Best '026 discloses audio associated with a player determined scene

Best '187 discloses audio associated with a player determined scene

Best '131 discloses audio associated with a player determined scene

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Hotaling II whose telephone number is (703) 305-0780. The examiner can normally be reached Monday- Friday from 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (703) 308-2217.

JMH
3/1/99

Jessica J. Harrison
Supervisory Patent Examiner
Group 3700